

Attorney Docket No. LWEP:121US
U.S. Patent Application No. 10/735,394
Reply to Advisory Action dated September 22, 2006
concerning Office Action of June 13, 2006
Date: October 26, 2006

Remarks

Amendments to the Drawings

Applicants courteously submit that the Reply to Office Action dated May 4, 2006 included amendments to Figures 1 and 2. However, Examiner has not provided any disposition regarding such proposed amendments. Therefore, Applicants respectfully request acknowledgement and entry of amended Figures 1 and 2, as filed on May 4, 2006, which action is appropriate.

Amendment to Specification

Applicants have amended paragraph [0005] of the specification to correct a typographical error in the original specification. In paragraph [0005] the number of the European document has been correct from EP 479 005 B1 to EP 0 429 005 B1. Applicants apologize for this inadvertent error and respectfully request entry of amended paragraph [0005] into the record.

Applicants have amended paragraph [0010] of the specification to provide further support for new Claims 49 and 50, as discussed below. In addition, Applicants have further amended paragraph [0010] to change the description of surface 9 from a “changing surface” to an “attachment surface” to more accurately describe its function. Applicants respectfully request entry of amended paragraph [0010] into the record.

New Claims

Applicants have added new Claims 49 and 50 which depend from Claims 3 and 8, respectively. Claims 49 and 50 recite embodiments in which photo beam 13 is deflected to second optical deflection unit 15 along a path parallel to the attachment surface. Support for these new claims is found in Figures 1 and 2 as originally filed and in amended paragraph [0010]. Because this parallel path is depicted in Figures 1 and 2 as originally filed, new Claims

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49 and 50 introduce no prohibited new matter. Applicants respectfully request entry of new Claims 49 and 50 into the record.

The Objections to Claims 4, 9, and 10

The Examiner objected to Claims 4, 9, and 10 stating that they all depend from Claim 3 and recite identical limitations. Applicants thank the Examiner for noting these informalities.

Applicants have amended Claims 4 and 10 to depend from Claims 1 and 8, respectively. Because Claim 1 does not provide antecedent basis for the claimed optical deflection element 11, Applicants have further amended Claim 4 to add optical deflection element 11 to the claimed invention by inserting the language “further comprising an optical deflection element (11) in said module and.” Claim 9 remains dependent upon Claim 3.

Claims 9 and 10 now depend from different claims than those suggested by the Examiner. However, Claims 9 and 10 claim an additional limitation to the optical deflection elements claimed in Claims 3 and 8, and more properly depend from those respective claims. Applicants respectfully request entry of amended Claims 4 and 10 and removal of the objections to Claims 4, 9, and 10.

The § 102 (b) Rejections of Claims 1, 2, 5, and 12

The Examiner rejected Claims 1, 2, 5, and 12 under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 4,619,503 to *Reinheimer et al.* (“Reinheimer” or “the Reinheimer patent”). In view of the amendments to Claims 1 and 2, Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131. (Emphasis added). In addition, “Every element of the claimed invention must be literally

present arranged as in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). (Emphasis added). Applicants have amended Claim 1 to recite an embodiment in which module 4 is removably attached to the U-shaped microscope housing. Support for this amendment is found in Figures 1 and 2. Applicants respectfully point out that the Reinheimer patent does not disclose an embodiment in which a module supporting the photo tube and/or the binocular tube is removable from the microscope housing or “C-shaped microscope body” described in Reinheimer. The C-shaped microscope body is analogous to the U-shaped housing claimed in Claim 1. See, for example, col. 2, lines 41-42 and 48-49 in Reinheimer. Because Reinheimer fails to disclose a removable module, it fails to disclose each element of Claim 1 and thus fails to anticipate Claim 1. Applicants respectfully request reconsideration and allowance of Claim 1.

Claims 2, 5, and 12 depend from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the Reinheimer patent fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 2, 5, and 12. Applicants respectfully request the removal of the rejections of Claims 2, 5, and 12 and allowance of those claims.

In addition, Applicants specifically traverse the rejection of Claim 2 as anticipated by the Reinheimer patent. Claim 2 recites an invention in which the photo tube and binocular tube are contained on a one-piece combination module. Applicants respectfully submit that while the Reinheimer patent describes several embodiments of its claimed invention, it fails to explicitly disclose a one-piece module that contains both a binocular tube and a photo tube. A close examination of the Reinheimer patent shows that in each embodiment disclosed in that patent, the photo module, reference no. 23 in Figure 3 and reference no. 22 in Figure 4, are separate elements disconnected from the camera. In contrast, Claim 2 claims the invention in which both the photo tube and binocular tube are contained in the same module. Consequently, the Reinheimer patent fails to anticipate Claim 2 as it not only fails to disclose the removable attachment of the module to the U-shaped housing, it also fails to disclose both the photo tube

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and the binocular tube arranged together in one module. Based on these additional grounds, Applicants respectfully request reconsideration and allowance of Claim 2.

Claim 12 depends from Claim 2 and thus incorporates all the limitations of that claim. Because, as discussed above, the Reinheimer patent fails to anticipate all the elements of Claim 2, it also fails to anticipate Claim 12. For this additional reason, Applicants respectfully request the removal of the rejection of Claim 12 and allowance of that claim.

The § 103 (a) Rejections of Claims 3, 4, 6-11 and 13-48

The Examiner rejected Claims 3, 4, 6-11, and 13-48 under 35 U.S.C. § 103 (a) as obvious over the Reinheimer patent. As described *supra*, Applicants have amended independent Claim 1 from which the rejected claims directly or indirectly depend. Applicants respectfully traverse this rejection and request reconsideration for the reasons set forth above and the following reasons.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In addition, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants respectfully point out that Claims 3, 4, 6-11 and 13-48 depend from Claim 1 and thus claim a microscope with a U-shaped housing and a module removably attached to the housing. This is significant because Claims 3, 4, 6-11 and 13-48 all incorporate the limitations of Claim 1. As noted above, Reinheimer provides no disclosure of a module that is removable from the C-shaped stand which is analogous to the claimed U-shaped housing. Therefore, for this first

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reason, Applicants respectfully submit that the Reinheimer patent fails to render obvious Claims 3, 4, 6-11, and 13-48.

Moreover, Claims 3, 4, 8-11, and 13-48 all claim the embodiment in which the optical deflection element (11) is within the module, not within the U-shaped housing. (See Claims 3 and 8 claiming the arrangement “wherein the vertical optical axis (10) of the observation beam bundle, extending in the one limb (2), penetrates through a first optical deflection element (11) after entering the base unit (5)...” (Emphasis added). In the claimed arrangement, optical deflection element 11 is positioned within the removable module to receive the observation beam bundle after it enters base unit (5). Base unit (5) is the base of the removable module. (See Figure 1). The optical deflection element acts to pass light to the binocular tube and/or deflect light to the photo tube. Reinheimer fails to render this structure obvious because it fails to suggest or teach this placement of the optical deflection element in the removable module. Without the placement of the optical deflection element in the module, the module cannot be removed and turned 90° as described in paragraph [0013] and still receive light from the same immovable light source. Thus, the Reinheimer patent fails to establish a *prima facie* case of obviousness against the rejected claims as the lack of a teaching from the Reinheimer patent that the optical deflection element may be placed in the removable module makes it unobvious to a person of ordinary skill how the module can be removed, rotated, reattached, and still receive light from the same immovable light source.

In contrast, Applicants respectfully point out that the optical deflection element that deflects light to the photo tube or camera in Reinheimer is located in the housing of the microscope. (See elements 9, 20, and 21 in Figure 3 and element 25 in Figure 4). Also, Figure 5b, depicting the embodiment with the rotating arm, lacks a single optical deflection element that both deflects light to a photo tube and allows light to pass to a binocular element. Therefore, the Reinheimer patent fails to render Claims 3, 4, 8-11 and 13-48 obvious as it fails to teach or

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suggest the placement of the optical deflection element within the removable module. Applicants respectfully request reconsideration and allowance of Claims 3, 4, 8-11, and 13-48.

In addition, Applicants specifically traverse the rejections of Claims 8, 11, 15, 19, 23, 27, and 34 as obvious over the Reinheimer. Claims 8, 11, 15, 19, 23, 27, and 34 depend directly or indirectly from Claim 2 and thus incorporate all the elements of that claim. In particular, Claims 8, 11, 15, 19, 23, 27, and 34 claim the microscope in which the photo tube and the binocular tube are contained on the same module. As noted above, Reinheimer fails to suggest or teach this element of those claims and thus fails to teach or suggest all the elements of Claims 8, 11, 15, 19, 23, 27, and 34. Applicants respectfully request reconsideration and allowance of Claims 8, 11, 15, 19, 23, 27, and 34.

Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned agent of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,

A handwritten signature in black ink, appearing to read 'Robert C. Atkinson', with a long horizontal flourish extending to the right.

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Dated: October 26, 2006